## REMARKS

Applicant acknowledges the courtesy of a telephonic interview with Examiner Carlson which interview was initiated by the undersigned attorney on November 4, 2004. At that time, counsel outlined the amendments that were contemplated, as now discussed below in greater detail, and sought the Examiner's approval of the procedure counsel proposed, namely abandoning application No. 08/311,665 and reasserting its claimed subject matter in this application. The Examiner indicated the abandonment of No. 08/311,665 would render the double patenting rejection moot and that subject to their formal presentation, the proposed amendments appeared to overcome all other outstanding rejections and objections.

The claims remaining and pending in this application are 226-235 and 238-242.

Claims 236 and 237, held to be withdrawn from consideration, have been cancelled without prejudice to their reassertion in a duly filed divisional application.

Claims 228-231 stand rejected under 35 U.S.C. § 112, 2nd ¶, as containing phraseology lacking antecedent basis. Claim 228 has been amended to delete the term "uninterrupted". The resulting phrase, "DNA sequence", finds antecedent basis in subparagraph (a) of claim 228. Withdrawal of the rejection is respectfully requested.

Claims 226-235, 238, and 239 were provisionally rejected under the judicially created doctrine of double patenting over claims 19-21 of co-pending application No. 08/311,665. Applicant respectfully disagrees with the premise of this rejection, namely that a claim directed to a DNA molecule and one directed to a vector containing such a molecule are not patentable distinct when the Patent and Trademark Office itself has defined two interference counts having precisely that

relationship to one another. Two counts thus reflects a finding by the Patent and Trademark Office of *two patentable inventions* under 37 CFR §1.601(n). Such a relationship, requiring that one count be patentable over the other count under 35 U.S.C. § 103 on the hypothetical assumption that one is prior art, is, it is submitted, the antithesis of "not patentably distinct". If the two sets of claims define separate patentable inventions before the interferences, they should have the same relationship after the interference.

Notwithstanding this disagreement, Applicant is herewith attempting to render this issue moot in order to resolve all issues in this long-pending application. Applicant is thus expressly abandoning No. 08/311,665, but not the invention claimed therein. Instead the subject matter of claims 19-21 in No. 08/311,665 is reasserted here as new claims 240-242.

It is appreciated that with the cancellation of claims 236 and 237, the presentation of claims 240-242 represents a net increase of one (1) claim. It is submitted, however, that that minimal increase in the number of claims does not contravene the rationale of MPEP § 714.12 or § 714.13 nor the principle of *Ex parte Wirt*, 1905 CD 247, 117 O.G. 599 (Comm'r Pats. 1905).

Applicant submits the following as a showing of good and sufficient reason under 37 CFR §1.116(c) as to why the amendment should be admitted; *i.e.*, why one additional claim should be permitted.

(*i*) The need for the single additional claim arises not from the assertion that it places the application in better condition for appeal (as in *Ex parte Wirt*) but as a consequence of Applicant's good faith attempt to meet all of the Examiner's rejections and to place this application in condition for allowance. Applicant thus is removing the basis for the double patenting rejection, the only remaining rejection of significance while, at the same time, maintaining Applicant's undisputable right to claim the subject matter of the application that is being abandoned. The

allowability of the other claims in this application should not be depend upon Applicant abandoning other claims to which he is otherwise entitled.

(*ii*) The additional claim also places no significant burden on the Examiner since the subject matter of that claim has already been examined and, apart from a parallel double patenting rejection, apparently found to be in allowable condition. That allowability should not be dependent on the application in which it is found (assuming the same disclosure, as is here the case).

(*iii*) Nor does the amendment adding the additional claim raise any new issue. No issue of support under 35 U.S.C. § 112 arises since No. 08/311,665 was filed as a continuation of this application and thus has an identical disclosure.

(*iv*) No additional search is involved since no art other than that which has been considered over the ten years these applications have been pending appears to be applicable.

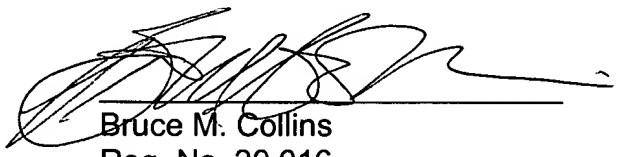
(*v*) Finally no additional examination is required since the subject matter of claims 240-242 has already been examined as claims 19-21 in No. 08/311,665.

It should be noted that Applicant also could assert the additional subject matter by refiling this application. The present application, however, has already been pending for over a decade and little would be gained on the part of the Patent and Trademark Office by requiring Applicant to go through the formalities of refiling yet again. The public would benefit in no way by delaying issuance yet again of otherwise allowable subject matter.

During the interview on November 4, 2005, Examiner Carlson indicated that the amendments appeared to place this application in condition for allowance and acknowledged that she that would not object to the Amendment on the grounds there was a net increase of one claim.

Finally, Applicant notes that documents concerning an amendment to inventorship in this application were submitted with the Amendment of July 28, 2004 (COM). Since the Official Action of October 14, 2004 contains no discussion thereof, it is assumed the same have been accepted without objection and that the inventorship has been accordingly corrected.

Respectfully submitted,



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